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REMARKS

1. Posture of the case. Claims 1-21 were originally submitted. A first Office action of August 10, 2005, rejected all claims under 35 USC 103(a) as being unpatentable over certain prior art and rejected claims 1-14 under 35 USC 101 as being directed to non-statutory subject matter.

Appellant filed Reply A on November 10, 2005, responsively amending claims 1, 4, 5, 7, 8, 11, 12, 14, 15, and 18-21 to overcome the rejections. Appellant also canceled claims 2, 3, 9, 10, 16, and 17.

A Final Office action of January 27, 2006 withdrew the rejections under 35 USC 101 and finally rejected all claims under 35 USC 103(a).

In response, Appellant filed an Appeal Brief on June 27, 2006. Appellant also filed a Reply Brief on November 27, 2006 in response to Examiner's Answer of September 26, 2006. In response to an April 17, 2007 Order Returning Undocketed Appeal to Examiner from the Board of Patent Appeals and Interferences, Examiner issued a non-final Office action on May 3, 2007.

This is a reply to the non-final Office action of May 3, 2007, in which claims 4-6, 11-13, and 18-20 are rejected under 35 USC 112, 2nd paragraph, and 1, 4-8, 11-15, and 18-21 are rejected under 35 USC 103(a) as being unpatentable over U.S. Patent Application 2002/0029154 ("Majoor"), U.S. Patent Application 2002/0184265 ("Gupta"), U.S. Patent 5,893,098 ("Peters ") and U.S. Patent 6,826,540 ("Plantec").

Applicant herein submits amendments to claims 4, 11, and 18 overcome the rejections under 35 USC 112, 2nd paragraph, and amendments to claims 1, 8, and 15 to overcome the rejections under 35 USC 103(a). Applicant cancels certain of the claims as indicated herein.

2. Arguments

Claims 1, 8, and 15

The Office action relies upon Majoor for teaching about storing a survey document having questions and answers on a first computer for delivery to a second computer. However, Majoor also teaches away from the present invention, especially as now even more particularly claimed. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v.

Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). In KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007), the United State Supreme Court states "Teleflex has not shown anything in the prior art that taught away from the use of Asano," thereby reinforcing the weight of this principle in a proper obviousness analysis. And since then, the United States Court of Appeals for the Federal Circuit has repeated that "it remains necessary to identify some reason . . . to modify . . . in a particular manner to establish prima facie obviousness" and found that a holding of nonobviousness was proper where there was teaching away. Takeda Chemical Industries, LTD. v. Alphapharm Pty., LTD., 06-1329, *10-13 (Fed. Cir., June 28, 2007).

Majoor does concern survey documents, but teaches that a first computer (which Examiner identifies as Majoor's *rule server* in Reply Brief Noted, February 28, 2007) analyzes answers sent back from a second computer (which Examiner identifies as Majoor's *client* computer system) and selects and sends next questions to the second computer responsive to those received answers. Majoor, para. 16-17. Claims 1, 8 and 15 in the present application now even more particularly state that instructions are for enabling the second computer to receive answers *from a user* and present next questions to the user responsive to those received answers *without intervention by the first computer.* Thus, it should be understood that the teaching away by Majoor indicates the nonobviousness of what is claimed in the present case.

The Office action relies upon Gupta for teaching about questions and answers stored in a markup language format. Gupta, para. 19. However, Gupta also teaches away from what is claimed in the present application about questions and answers. Gupta teaches that the questions and answers are for a program that generates tests by randomly selecting questions and that generates corresponding written answer keys. See, e.g., Gupta, para. 5-6 and FIG. 1. Thus Gupta teaches that the program generates *answers responsive to questions* and also that *the program randomly selects the questions.* By contrast, claims 1, 8 and 15 in the present application state that the instructions for receipt and execution as an applet in a browser of the second computer system cause "the second computer system to then repeatedly select and display additional sets of one or more of the questions and corresponding, selectable answers, wherein the repeated selecting and displaying of the additional sets of one or more of the questions and corresponding, selectable answers is by the second computer and not the first computer and is responsive to

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answers selected by the user on the second computer." Thus, it should be understood that the teaching away by Gupta further indicates the nonobviousness of what is claimed in the present case. This was pointed out previously in Applicant's Reply A of November 10, 2005, Appeal Brief of June 27, 2006, and Reply Brief of November 27, 2006.

The Office action relies upon Plantec for teaching about parsing. Plantec does concern conducting surveys and compiling results, and does include some teaching about a different kind of parsing arrangement. Plantec teaches that a *results server* receives and parses an answer file compiled from survey results obtained by user interaction elsewhere. Plantec, col. 38, lines 33-48. However, Plantec also teaches away from other aspects of what is claimed, including certain parsing aspects. In particular, claims 1, 8 and 15 state that a survey document and programming instructions are stored on the first computer system for delivery to the second computer system, which enables user interaction with a survey presented on the second computer and return of user selected answers to the first computer. That is, according to the claims, as herein amended, the instructions enable parsing of questions and answers from a survey document by the second computer and presenting next questions and answers to the user by the second computer responsive to answers selected by the user on the second computer *without intervention by the first computer*. See. e.g., amended claim 1 ("the repeated selecting and displaying of the additional . . . questions and . . . selectable answers is by the second computer and not the first computer and is responsive to answers provided by the user directly to the second computer without intervention by the first computer."). Claims 8 and 15 have similar language. Thus, it should be understood that the teaching away by Plantec indicates the nonobviousness of what is claimed in the present case.

Claims 1, 8 and 15, as herein amended, now also make all the more clear that the present invention includes additional aspects that are not taught or suggested by the art of record. That is, claim 1, for example, includes "storing an HTML formatted survey document on a computer-readable medium of a first computer system, the survey document having questions and answers in a certain format, wherein ... the questions and answers are defined as XML data elements included in the survey document," and "storing an HTML formatted document and programming instructions on a computer-readable medium of the first computer system ... the programming instructions including ... first instructions for receipt and execution as an applet in

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a browser of the second computer system … caus[ing] the second computer system to parse the data elements …"

The claim goes on to recite that the program instructions include "second instructions for receipt and execution as an applet in a browser of the second computer system … caus[ing] the second computer system to display in a browser … questions and corresponding, selectable answers and … then repeatedly select and display additional … questions and corresponding, selectable answers … responsive to … the cross-references…"

As noted above, the claim goes on to recite that "the repeated selecting and displaying of the additional … questions and … selectable answers is by the second computer and not the first computer and is responsive to answers selected by the user on the second computer …"

Finally, claim 1 states that the program instructions include "third instructions … wherein the execution of the third instructions as an applet causes the second computer to return survey results to the first computer system as an XML formatted answer response document defining the answers selected by the user as data elements included in the survey document as strings of text surrounded by text markups, including tags, wherein the text markups describe the data elements." Claims 8 and 15 have similar language. Thus, it is all the more clear that the references cited do not teach or suggest, neither alone nor in combination, what is now claimed.

The cited references merely show that certain limited aspects, but not all aspects, of the claimed invention were individually known in the art. Even aside from their deficiency in teaching all of what is now claimed, no sufficient reason has been articulated for combining the four references relied upon for the rejection of claims 1, 8 and 15. The Office action contends "It would have been obvious . . . to include the parsing of a document into an array . . . to provide a more efficient data collection method for the conversion of the information into a form useful for the survey sponsor. Therefore, it would have been obvious to combine the teachings of Plantec with Peters, Gupta and Majoor for the benefits of allowing a more efficient and portable survey system capable of using previous answers for the dynamically determining questions." Applicant submits that combining teachings of Plantec with Peters, Gupta and Majoor for allowing a more efficient and portable survey system using previous answers for dynamically determining questions does not follow from parsing a document into an array to provide more efficient data

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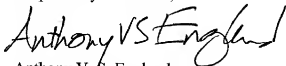
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collection and conversion of information into a useful form for a survey sponsor, particularly in view of how these references teach away from the claimed combination.

No new matter is added, since the original application provides support for these amendments. See present application as published (2003-0033193 A1) paragraph 25 (HTML formatted survey document); paragraph 25 (XML data elements); paragraph 24 (programming instructions written in an object oriented, interpreted, dynamic programming language); paragraph 24 (receipt and execution as an applet in a browser); paragraph 39 (execution of applet causes second computer system to parse data elements); paragraph 40 (execution of the applet causes second computer system to then repeatedly select and display additional sets of one or more of the questions and corresponding, selectable answers); paragraphs 39 and 40 (repeated selecting and displaying of the additional sets of one or more of the questions and corresponding selectable answer by the second computer system and not the first computer (i.e., "The method steps of the algorithm 800 are performed by the client 150 (FIG. 1)... ") where the selecting and displaying is responsive to answers selected by the user on the second computer); paragraph 26, Fig.'s 3-7, paragraphs 33-38 (repeated selecting by the second computer system further responsive to ones of the cross-references of the data arrays arising from the second computer system parsing the data elements from the survey document); paragraph 27 (third instructions for receipt and execution as an applet in a browser of the second computer system causing the second computer to return survey results to the first computer system as an XML formatted answer response document defining the answers selected by the user as data elements included in the survey document as strings of text surrounded by text markups, including tags, wherein the text markups describe the data elements).

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REQUESTED ACTION

For the above reasons Applicant submits that the invention as claimed in accordance with amendments submitted herein is patentably distinct, and hereby requests that Examiner grant allowance and prompt passage of the application to issuance.

Respectfully submitted,

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